TH

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,534	01/29/2004	David W. Brown	U 0209-F01A	5355

23657 7590 06/14/2007

COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

EXAMINER	
BRUNSMAN, DAVID M	
ART UNIT	**PAPER NUMBER**
1755	
MAIL DATE	**DELIVERY MODE**
06/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/767,534	BROWN ET AL.	
	Examiner	Art Unit	
	David M. Brunsman	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21,31,32,35-43 and 45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21,31,32,35-43,45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Applicant's response filed 26 march 2007 has been carefully considered.

The rejection of claim 22 under section 112 is moot in view of its cancellation.

The rejection of claims 1-3, 6-24, 26-32 and 35-41 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5827453 is withdrawn in view of applicant's amendment.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 and 31, 32, 35-40 and 45 are rejected under 35 U.S.C. 102(a or e) as being anticipated by US Patent 6350787.

Example 7 teaches the reaction product of epichlorohydrin and isodecyl alcohol . 8 EO in a ratio of 1.1 in 96% of a wax/oil vehicle. With respect to claim 5, the term "about 3%" is anticipated by the disclosure of 4% reaction product.

The disclosure includes the reaction product of the instant claims present in a non-aqueous liquid. Claims to a composition are anticipated by a disclosure of the same composition regardless of the inventor's reasons for forming the composition. As set forth in the explanation of the claim construction above, the intended use of a composition is not effective as a material limitation in a composition of matter class claim.

The amendment to the claims adds the limitation that the composition exhibits the property such that it "forms a substantially smooth and uniform film when spray applied to a hard substrate and dried". The response presents no evidence or reasoning supporting its assertion that polyethylene/wax/defoamer composition of the prior art would not form "a substantially smooth and uniform film when spray applied to a hard substrate and dried". Formation of smooth uniform films using sprayed hot wax is notorious. One of ordinary skill in the art would expect a smooth uniform film to be formed absent evidence to the contrary.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6350787, as applied above.

This application qualifies as prior art under 35 U.S.C. 102(a) for forming the basis of a rejection under 103(a).

The difference between claims 21 and 41 and example 7 of the reference is the number of EO groups in the reaction product. Claim 5 of the reference teaches that compounds containing 4-50 EO groups are equivalent in the invention of the reference. It would have been obvious to one of ordinary skill in the art to use the same compound having 4 EO groups because they are recognized as equivalents in the art. US Patent 6350787 is not disqualified under 102(a) as disqualification is only available under parts e, f and g.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this

application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21, 31, 32, 35-41 and 45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10 of U.S. Patent No. 6583185. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1-3, 6, 7, 11-13, 31, 32 and 45 fully encompass claim 1 of the patent. Claims 4, 5, 8-10, 14-21 and 35-41 are anticipated by claims 1-5 and 10 of the Patent. The patent claims disclose a composition comprising the (base catalyzed) reaction product of epichlorohydrin and a compound of formula II such as $C_{10}H_{21}O(EO)_8OH$ in a ratio of 0.6011 to 2.0, a hydrophobic solid and a water-insoluble carrier. The term "water-insoluble" implicitly excludes aqueous carriers. The difference between claims 21 and 41 and claim 10 of the patent is the number of EO groups in the reaction product. Claim 5 of the patent teaches that compounds containing 4-50 EO groups are equivalent in the invention of the reference. It would have been obvious to one of ordinary skill in the art to use the same compound having 4 EO groups because they are recognized as equivalents in the art.

The amendment to the claims adds the limitation that the composition exhibits the property such that it "forms a substantially smooth and uniform film when spray applied to a hard substrate and dried". The response presents no evidence or reasoning supporting its assertion that composition of 6583185 would not form "a substantially smooth and uniform film when spray applied to a hard substrate and dried. One of ordinary skill in the art would expect a smooth uniform film to be formed absent evidence to the contrary.

Claims 1-21, 31, 32, 35-41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6583185 for the same reasons as set forth above in the obviousness-type double patenting rejection.

Claims 1-21, 35-43 and 45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 and 22 of U.S. Patent No. 6572691. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The patent specification defines terms used in the patented claims. Column 4, lines 23-39 that the ink comprises pigment in a drying oil or petroleum solvent and "surfactant effective of

defoaming effective quantity" as 0.001-20%. The disclosure that the inks of the patent include ball point pens inks is a disclosure of a nonaqueous coating composition as ball point inks are conventionally recognized in the art as non-aqueous.

The claims of the patent disclose a ink composition (claim 22) comprising (see claim 1) a liquid vehicle, colorant and the (base catalyzed) reaction product of at least one compound of formula I, such as epichlorohydrin (claim 5, 11) and a compound of formula II such as isodecyl alcohol . 4 EO (Claim 20); in ratio of 0.1 to 5 (claim 2), 0.8 to 2 (claim 3) or, 1 to 1.5 (claim 4). As "paint" is defined as a liquid mixture of solid pigment in a liquid vehicle and "enamel" is a paint that dries to a hard finish. The disclosure includes the reaction product of the instant claims present in a non-aqueous liquid. Claims to a composition are anticipated by a disclosure of the same composition regardless of the inventor's reasons for forming the composition. As set forth in the explanation of the claim construction above, the intended use of a composition is not effective as a material limitation in a composition of matter class claim.

The amendment to the claims adds the limitation that the composition exhibits the property such that it "forms a substantially smooth and uniform film when spray applied to a hard substrate and dried". The response presents no evidence or reasoning supporting its assertion that ink composition of Brown would not form "a substantially smooth and uniform film when spray applied to a hard substrate and dried". One of ordinary skill in the art would expect a smooth uniform film to be formed absent evidence to the contrary.

The claims of Brown anticipate the instant claims as explained. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either *anticipated* by, or would have been obvious over, the reference claim(s).

To be considered timely, a proper Terminal Disclaimer must be submitted in the first response to this final rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, Th, F, Sa; 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David M Brunsman
Primary Examiner
Art Unit 1755

DMB